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REMARKS

The examiner required Applicant to restrict the application to either invention I (claims 1-25) or invention II (claim 26). Applicant elected invention I (claims 1-25) and herein withdraws claim 26.

The examiner objected to the specification because "the first line of the specification should include reference to the provisional priority." Applicant's attorney respectfully directs the examiner's attention to page 1, lines 4 and 5 of the application to the sentence, "This application claims the benefit of U.S. Provisional Application No. 60/437,222 filed December 31, 2002." Applicant's attorney requests a telephone conference with the examiner if there is a need to amend this claim to priority.

The examiner rejected claims 1-2, 22 and 24-25 under 35 U.S.C. §102 as being anticipated by the Wnenschak reference (U.S. Patent No. 5,368,734). The examiner stated that Wnenschak

"teaches a filter medium of polypropylene and modacrylic fibers... wherein the fibers includes measurable amounts of extractable organic contaminants (lubricants, antistatic agents, etc) as in the table of col. 4, including amounts up to about .1%."

Claim 1 has been cancelled and the limitations thereof have been incorporated into claim 2.

The table in column 4 referenced by the examiner includes three fiber blends that include polypropylene and modacrylic fibers, and displays the "Milligrams of Contaminants (Per m² of filter material)" for each of those blends. The three amounts for the materials at issue are 362.86, 348.59 and 223.05 mg/m². The samples had a mass of 110g/m² (see col. 3, line 55), thus resulting in a weight percentage of extractables of

.33%, .32% and .20%. The amounts given in Wnenchak are two to three times as much as the upper limit of the range Applicant claims in amended claim 2.

Although it could be argued that the Wnenchak patent teaches to have some extractables on polypropylene and modacrylic fibers in the range of .2 percent to .33 percent, it is incorrect to state that Wnenchak teaches extractables "less than about 0.1 weight percent" as Applicant claims. Thus, amended claim 2 is allowable over the Wnenchak reference under 35 U.S.C. §102.

The examiner next rejected claims 1-25 under §102 as being anticipated by Brown (U.S. Patent No. 4,798,850) as evidenced by Wnenchak and Legare (U.S. Patent No. 6,211,100). The examiner uses the Legare patent to evidence that the material used in the Wnenchak patent ("Technostat") is the same material disclosed in the Brown patent ("The product described in [the Brown] patent is sold commercially under the trademark TECHNOSTAT..." see col. 3, lines 2-3 of Legare).

The examiner's rejection requires the assumption that the Brown patent is incorrect in at least one place, that the Legare patent is correct in at least one place but incorrect in at least another, and that the Wnenchak patent is correct on the same topic on which the Brown patent is incorrect. Applicant's different explanation below allows all the references to be correct, and shows that the prior art does not anticipate the invention.

The Brown patent states that "[b]y 'clean' we mean that the fiber has no coating of lubricant or anti-static agent, or that any such coating was removed before blending...." Brown clearly states that its fibers have no coating. This must be incorrect in order for the examiner's rejection to stand, because the examiner states that "what Brown considers to be 'clean' (substantially free) of extractables actually includes a

measurable amount.” (Office Action mailed 06/09/2006, page 4). The examiner thus corrects Brown using Wnenchak’s statement that Technostat, which Legare shows was used in Brown, actually contains .2% to .33% extractables.

It is unclear where the statement that Brown teaches fibers that are “substantially free” of extractables is in the prior art, because those words do not appear in Brown, Legare or Wnenchak. Brown teaches that its fibers contain “no coating”, not that the fibers are “substantially free” of coating. The person having ordinary skill would conclude from Brown that the fibers contain no coating of extractables. Thus, under the examiner’s explanation, Brown and Wnenchak are at odds regarding the amount of extractables in the Brown fiber blend.

There is another explanation to this apparent inconsistency. The only link between Brown and Wnenchak is the trademark Technostat. The trademark Technostat is registered in the U.S. Patent and Trademark Office under federal registration number 1,723,870 (see appended Exhibit 1: copy of trademark registration certificate). The trademark was registered on October 13, 1992 based on a priority document in the United Kingdom dated January 19, 1990. Despite the Legare patent’s statement, it is unclear whether the Brown patent (filed in 1987 based upon a 1986 priority document) used the same fiber blend sold under the trademark Technostat in 1992 (the Wnenchak priority date). Even if the blend was the same, there is no evidence that the amount of extractables was the same. If this is not required, then the only link between Brown and Wnenchak disappears.

There is no description of the goods in the Technostat registration other than the identification of goods (“nonwoven fibrous material for use in air filters”). Many fibrous

blends that do not meet the claim limitations could be described by this identification of goods. The owner of the Technostat trademark could, without violating trademark law, change the composition of its fiber blend during the life of the trademark and the registration. This the only reasonable explanation for Wnenchak's and Brown's apparently inconsistent statements about the extractable content.

The examiner cited the Legare patent for support of the statement that the fiber blend explained in detail in the Brown patent was sold under the trademark Technostat. However, Legare also states that the Technostat material has fibers that "are scoured to remove all surface contamination, to enable formation of a stable triboelectric charge." See col. 2, lines 48-49. Thus, the Legare patent, which must be correct regarding Technostat for the examiner's rejection to stand, must be incorrect here. This raises doubt about Legare's reliability unless one accepts that different Technostat compositions are possible.

The evidence shows the following: Brown and Legare state that Brown's material contains no extractables. Legare states that Brown's patented material is sold under the trademark Technostat. Wnenchak states that Technostat contains .2 to .33 percent extractables. Not all of these factors can be interpreted as the examiner suggests and still be consistent. The only explanation that allows consistency between references is that the material sold under the trademark Technostat has changed in its composition so that Wnenchak's measurements show extractables, whereas Brown and Legare show none.

Thus, the prior art teaches a fiber blend with no extractables whatsoever (Brown, Legare), and a fiber blend with .2% to .33% extractables (Wnenchak). Applicant's claimed composition is allowable, because it does not claim the prior art. Instead,

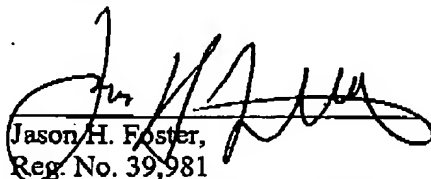
Applicant claims about 0.1% or less extractables, but still a measurable amount. No prior art reference teaches this range, and therefore amended claims 2 and 24 are allowable, as are all claims dependent thereon. Therefore, reconsideration and allowance are respectfully requested.

The examiner is authorized to communicate with the undersigned attorney by email by the following recommended authorization language: Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file. (authorization pursuant to MPEP 502.03)

The Commissioner is authorized to charge Deposit Account No. 13-3393 for any insufficient fees under 37 CFR §§ 1.16 or 1.17, or credit any overpayment of fees.

Respectfully submitted,

10 Oct. 2006
Date of Signature



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Enclosures: Exhibit 1
Petition for Extension of Time
Credit Card Payment Form

EXHIBIT “1”

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Int. Cl.: 24

Prior U.S. Cl.: 42

United States Patent and Trademark Office Reg. No. 1,723,870
Registered Oct. 13, 1992

**TRADEMARK
PRINCIPAL REGISTER**

TECHNOSTAT

HEPWORTH MINERALS AND CHEMICALS
LTD. (UNITED KINGDOM CORPORATION)
BROOKSIDE HALL
SANDBACH
CHESHIRE CW11 OSS, ENGLAND

FOR: NONWOVEN FIBROUS MATERIAL
FOR USE IN AIR FILTERS, IN CLASS 24 (U.S.
CL. 42).

PRIORITY CLAIMED UNDER SEC. 44(D) ON
UNITED KINGDOM APPLICATION NO.
1411412, FILED 1-19-1990, REG. NO. A1411412,
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SER. NO. 74-054,657, FILED 5-1-1990.

ANDREW D. LAWRENCE, EXAMINING AT-
TORNEY